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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/297,399	04/29/99	MIYAMOTO	M 3404/0F546-U

IM22/0830

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EXAMINER

SHOSHO, C

ART UNIT	PAPER NUMBER
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1714

*17*

DATE MAILED:

08/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Advisory Action

Application No.  
09/297,399

Applicant(s)  
Miyam t

Examiner  
Calle Shosh

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1714



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Aug 15, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

### THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Aug 15, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
  - (b) ☐ they raise the issue of new matter. (See NOTE below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

4. ☐ Applicant's reply has overcome the following rejection(s):  
\_\_\_\_\_  
\_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see attachment  
\_\_\_\_\_
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: None  
Claim(s) objected to: None  
Claim(s) rejected: 1-5
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☐ Other:

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**Attachment to Advisory Action**

1. Applicant's arguments filed 8/15/01 have been fully considered but are not persuasive.

(a) With respect to JP 6346014, applicant has provided comparative data wherein an ink comprising the thickener disclosed by the Japanese reference, i.e. Primal RM-5, is compared with inks of the present invention as found in examples 2, 4, and 8 on pages 21-22 of the present specification. Applicant has shown that the ink of the present invention is superior to the ink of the Japanese reference in terms of ink seepage resistance, writing property, stability, etc. However, the declaration is not successful in removing JP 6346014 as a reference against the present claims because the fact remains that thickener disclosed by the Japanese reference is still encompassed within the scope of the present claims. That is, the present claims require a thickener which is associative and swells in an alkaline medium wherein the thickener has carboxyl group and hydrophobic group which clearly describes the thickener utilized in JP 636014. Thus, while JP 6346014 may not disclose the specific type of thickeners utilized in the present invention, JP 6346014 do disclose thickeners as required by the present claims. Thus, it is the examiner's position that the disclosure of thickener in the present claims clearly encompasses those utilized by JP 6346014.

Applicant argues that the specification makes clear that RM-5 is not contemplated to be a thickener used in the present invention. However, there is nothing in the present claims to indicate that these types of thickeners are in fact excluded. As described on page 10, lines 4-8 of

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the specification RM-5 is an associative thickener which clearly reads on the scope of the present claims. Further, this disclosure provides further evidence that the thickener disclosed by JP 636014 is an associative thickener which meets the limitations of the present claims.

**Note:** If applicant were to amend the claims in order to limit the thickener to those thickeners which are outside the scope of the thickeners disclosed in JP 636014, it is the examiner's position that this would help materially advance the prosecution of the application.

(b) With respect to Okumura et al., similar to the arguments set forth above, it is noted that while applicant has submitted comparative data establishing the superiority of the presently claimed inks, there is nothing in the present claims which excludes the thickeners as disclosed by Okumura et al.

Further, applicants argue that Okumura et al. does not teach a thickener which is associative and swells in an alkaline medium. However, Okumura et al. do disclose thickener, for instance, which is an alkali salt of copolymers of styrene and maleic acid. Thus, given that Okumura et al. disclose thickener as presently claimed, i.e. contains hydrophobic group and carboxyl group, it is natural to infer, absent clear and convincing evidence to the contrary, that the thickener of Okumura et al. would intrinsically function the same as the thickeners presently claimed, i.e. as an associative thickener which swell in alkaline medium. Support for this position of inherency of properties is found in Titanium Metals Corp. V. Banner, 227 USPQ 773 (Fed. Cir. 1985) where the court held that in comparing claimed and reference compositions it

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was immaterial what properties the compositions had or who discovered the properties of the compositions because "the composition is the same and thus must necessarily exhibit the properties" and In re Spada, 15 USPQ 2d 1655, 1658 (Fed. Cir. 1990), "products of identical chemical composition can not have mutually exclusive properties" and "a chemical composition and its properties are inseparable".

Additionally, applicants have supplied comparative data, i.e. Primal TT-615 brochure, wherein it is shown that Primal TT-615 increase viscosity over a given pH range while polycarboxylic acid thickeners decrease viscosity over the same range. However, this comparison is not persuasive given that Okumura et al. do disclose thickener as presently claimed, and thus clearly meets the limitations of the present claims. Further, there is no requirement in the present claims that the thickener increase viscosity over a given pH range. While claim 2 discloses that there is an increase in viscosity, there is no indication of the pH at which this increase occurs. For instance, from the brochure it can be seen that for polyacrylic acid thickeners as the pH decreases, the viscosity increases.



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8/29/01

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